

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) PF02200NA/10-031
I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office Fax No. 571-273-8300 on August 15, 2006 to the attention of Examiner Joseph E. Avellino of AU 2143		
Typed Name: <u>Charles W. Bethards</u>	Application No. 10/045,724	Filed Oct. 26, 2001
Signature: <u>Charles W. Bethards</u>	First Named Inventor: Huddleston	
	Art Unit: 2143	Examiner Joseph E. Avellino
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.		
This request is being filed with a notice of appeal.		
The review is requested for the reasons stated on the attached sheet(s). <u>Five (5) pages attached</u> Note: No more than five(5) pages may be provided.		
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record the entire interest.</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>36,453</u></p> <p><input type="checkbox"/> attorney or agent under 37 CFR 1.34(a). Registration number if under 37 CFR 1.34(a). _____</p>		
<p><u>Charles W. Bethards</u> Signature</p> <p><u>Charles W. Bethards</u> Typed or printed name</p> <p><u>817-581-7005</u> Telephone Number</p> <p><u>August 15, 2006</u> Date</p>		

PRE APPEAL BRIEF REQUEST FOR REVIEW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/045,724 Applicant: Huddleston, et al Filed: October 26, 2001
Examiner: Joseph E. Avellino TC/A.U.: 2143 Docket No.: PF02200NA/10-31

Accompanying Arguments/Discussion

History: The present application was filed on October 26, 2001. On or about February 9, 2005 a first Office Action was mailed that rejected all claims. An Amendment and Response was filed on or about June 9, 2005 wherein claim 18 was amended to clarify the claim language and arguments were advanced seeking to traverse the Examiner's claim rejections. On July 7, 2005 a Final Office action was mailed that maintained the original rejections of all 20 claims. An Examiner Interview was conducted on August 31, 2005 with an Interview summary mailed on September 8, 2005. An After Final response was filed on September 2, 2005 and on September 30, 2005 an Advisory Action was mailed, which indicated that the arguments presented in the September 30, 2005 After Final Response were not persuasive. On November 7, 2005 a Notice of Appeal was filed together with a Request for Pre-Appeal Brief Review and accompanying comments. Based on that Request, prosecution of this application was reopened and a non-final office action was mailed on February 21, 2006. An amendment was filed on May 22, 2006 in response to the February 21, 2006 Office Action. On June 15, 2006 a Final Office Action was received, wherein claims 1-20 were rejected, and Applicant's arguments in the May 2, 2006 amendment were deemed unpersuasive.

Status and this Response: Claims 1-20 are pending and stand rejected on varying grounds under §102(e) and 103(a). No claims are being amended, canceled, or added and no other papers are pending. In view of the comments below, Applicant respectfully submits that the rejections in the June 15, 2006 Final Office action are erroneous and thus requests that the Panel reconsider the present application including claims 1-20 and withdraw the rejection of these claims.

a) Claims 1-3, 5, 8, 9, 11-12, 15, and 17-20 stand rejected under 35 U.S.C. 102(e) as being anticipated by van Ee et al.(US Patent No. 6,774,813).

Claims 1, 11, and 18 are in independent form with all other claims dependent on the closest lower numbered independent claim. As noted in one or more responses, the present invention deals with various aspects of obtaining appropriate commands from a web site for effecting a desired function by an intelligent device. It is noted that Applicant is not claiming all approaches for programming a remote control; rather only those methods and apparatus of obtaining commands for an intelligent device as specifically defined by the claims. Claim 1

Appl. No. 10/045,724
Accompanying arguments, Pre-App Brief Request, filed August 15, 2006

defines a method that includes defining in a wireless internet access device (WIAD) a desired function to be performed by the intelligent device, identifying via the WIAD the intelligent device and desired function to a web site through a wireless communication network, returning to the WIAD from the web site a subset of control instructions for controlling the intelligent device to perform the desired function and forwarding the subset of control instructions to the intelligent device all as specifically claimed.

Van Ee et al. may be viewed as relevant art, however this reference is directed in the main to a different problem than the present invention, i.e., Van Ee et al is a scheme for determining what set of control commands work for a given TV, etc. so as to program a remote control device. Van Ee et al. discusses one approach for programming a control device 106 so that the device is able to control a given TV 102 or VCR 104, where the control device 106 is a programmable remote controller for consumer equipment (col. 5, lines 41-46). Van Ee et al. includes programming means 110 for programming the control device 106.

The programming means is contained within a set top box (STB) (connected to the TV) and this means 110 includes internet connection (modem) 114 for connecting via a wired connection and the Internet 116 to a remote server 118 (col. 5, lines 51- 59). The programming means includes a memory 112 that has a database of apparatus type/brand information, e.g., TV by Phillips (col. 5, lines 53-54). Access buttons on the STB or remote control 106 are used to access a database in the memory 112 and select from a menu displayed on the TV an apparatus type and brand, which is then transmitted via the Internet 116 to the remote server 118 (col. 5, line 66 to col. 6, line 8).

The remote server 118 searches for all sets of control codes corresponding to the apparatus/brand information. Once these sets have been identified, the remote server selects a control code corresponding to a particular function (e.g., ON/OFF) and returns the same to programming means 110 (col. 6, lines 9 - 20). This assortment of control codes is forwarded to control device 106, and each is tried until one works. The remote server is notified via means 110 of the last control code used where it is presumed that this code works (user quits pressing keys) and returns the corresponding full set of control codes to be programmed into the control device (col. 6, lines 24 – col. 7, line 2).

With reference to claim 1, the Examiner maintains that van Ee et al shows or suggests all features of claim 1 and with reference to claims 11 and 18 all features of these claims. Applicant respectfully disagrees. For example, claim 1 (analogously claims 11, 18) requires a WIAD and

Appl. No. 10/045,724
Accompanying arguments, Pre-App Brief Request, filed August 15, 2006

defining within the WIAD a desired function to be performed by the intelligent device (TV, etc of van Ee et al). The only devices in van Ee et al. that have any wireless functionality are the programming means (STB) 110 and remote control 106 (IR link). Neither of these devices at any time, define within the devices a desired function to be performed by the TV. At best one might argue that complete control is expected, however that is not defining a desired function and expecting return of a subset of control instructions as claimed. The STB does facilitate selection of an apparatus type and brand and does forward this to a remote server 118 (web site), however no desired function is indicated to the remote server and furthermore the identifying to the remote server is not performed via a wireless communication network. In van Ee et al. the remote server selects a subset of control instructions (e.g., ON/OFF) from each full set of instructions and this instruction for each apparatus type and brand is returned to the programming device 110 and remote control 106.

In view of the above comments, Applicant respectfully submits that van Ee et al does not show or suggest 1) the claimed WIAD, 2) the claimed defining a desired function in the WIAD, 3) the claimed identifying by the WIAD the desired function to a web site, or 4) the claimed identifying via a wireless communication network.

The Examiner in the June 15, 2006 Final Office action characterized these four distinct arguments as two arguments, i.e., i) that the programming means 110 is not the claimed WIAD and ii) that the desired function is not indicated to the remote server (page 6, §16). The Examiner indicates that the arguments are not persuasive and reasons with respect to i) that the programming device has wireless capability and this device can access the internet, ergo the means 110 is a wireless internet access device (WIAD) (page 6, §17). The Examiner further alleges the Applicant is reading limitations into the claim (page 6, §17); however Applicant is merely construing in a reasonable manner the words in the claim – i.e. a wireless internet access device is a device that provides wireless internet access.

The Examiner in the June 15, 2006 Final Office action reasons with respect to ii) that Applicant is incorrect and finds the defining a desired function to be performed by the intelligent device (as claimed) to be an inherent feature of the system of van El et al noting that this function is (retrieving control codes for the type/brand combination) (see page 7, §18). Applicant notes that retrieving control codes is not a function to be performed by the intelligent device as recited by claim 1 and the other independent claims.

Appl. No. 10/045,724
Accompanying arguments, Pre-App Brief Request, filed August 15, 2006

The Examiner does not address Applicant's other arguments, e.g., 4) wherein the identifying is performed via a wireless communication network.

Thus at least in view of one or more of the above reasons (e.g., absence of any teaching of the claimed WIAD or defining a desired function or identifying the desired function to a web site or doing so via a wireless communication network) all features of claim 1 or by analogy claims 11 and 18 have not been shown or suggested by van Ee et al. Hence, van Ee et al does not anticipate claim 1, 11, or 18 and thus does not properly support a §102(e) rejection of any one of these claims or any claim dependent on any one of these claims. Therefore and at least in view of these reasons, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection of claims 1-3, 5, 8, 9, 11-12, 15, and 17-20 under 35 U.S.C. 102(e) as being anticipated by van Ee et al.(US Patent No. 6,774,813).

b) Claims 4, 6, 7, 14, and 16 stand rejected under 35 US.C. 103(a) as being unpatentable over van Ee et al. in view of Maymudes (US Patent No. 6,748,278). Applicant notes that the Examiner arguments in the June 15, 2006 Final Office action refers to a Tessler reference (page 4, §12)?

Claims 4, 6, and 7 are dependent on claim 1, while claims 14 and 16 are dependent on claim 11. Maymudes does not show or suggest the features of claim 1 or claim 11 that are missing from van Ee et al and thus claim 1 and claim 11 should be allowable over this combination of references. Therefore, at least by virtue of dependency, claims 4, 6, 7, 14, and 16 should likewise be allowable over these references. Hence, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection of claims 4, 6, 7, 14, and 16 under 35 US.C. 103(a) as being unpatentable over van Ee et al. in view of Maymudes (US Patent No. 6,748,278).

c) Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over van Ee in view of Baun et al (US 2003/0197930). Applicant notes that the Examiner arguments in the June 15, 2006 Final Office action refers to a Tessler reference (page 5, §14)?

Claim 10 is dependent on claim 1. Baun et al. does not show or suggest the features of claim 1 that are missing from van Ee et al and thus claim 1 should be allowable over this combination of references. Therefore, at least by virtue of dependency, claim 10 should likewise be allowable over these references. Hence, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection of claim 10 under 35 US.C. 103(a) as being unpatentable over van Ee et al. in view of Baun et al (US 2003/0197930).

Appl. No. 10/045,724
Accompanying arguments, Pre-App Brief Request, filed August 15, 2006

d) The Examiner in the June 15, 2006 Final Office action reiterates that "Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art; that Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations; that the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, that the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention (... See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993); that Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims; and that The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention."

Applicant is appreciative of the Examiner's suggestions and certainly has no interest in portraying even the appearance of being unduly argumentative or inflexible. However, Applicant is unable to determine from the generalities offered by the Examiner what words or phrases the Examiner believes are subject to a broad construction that allows the cited references to be reasonably construed to show or suggest all features of the claims. If the Examiner or Panel has any specific suggestions that would move this application forward, Applicant would be very interested in considering such suggestions.

Accordingly, Applicant respectfully submits that the claims clearly and patentably distinguish over the cited references of record and as such are to be deemed allowable. Although it is not anticipated that any fees are due or payable since a Notice of Appeal fee was paid on November 7, 2005 and no final decision was reached in that Appeal, the Commissioner is hereby authorized to charge any fees that may be required to Deposit Account No. 50-3435.

Respectfully submitted,

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